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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,825	05/22/2001	Satoru Ueda	7217/64562	8871

7590 06/29/2004

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EXAMINER
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YIGDALL, MICHAEL J

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 06/29/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/862,825

Applicant(s)

UEDA, SATORU

Examiner

Michael J. Yigdall

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2004 and 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 23, 2004 has been entered. Claims 1-7 remain pending and have been examined.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Applicant contends that Reeder does not disclose a removable storage medium and a user terminal in which to install the removable storage medium (see page 6, last paragraph), and that the storage medium disclosed by Reeder is a hard disk rather than a removable storage medium (see page 7, top).

However, Oshima et al. (hereinafter "Oshima"), like Reeder, discloses a system for providing and managing access to a software program (see column 10, lines 15-54). The storage medium disclosed by Oshima for storing the software and an identification code is an optical disk, i.e. a removable storage medium (see 801 in FIG. 11). The removable storage medium is installed in a personal computer or user terminal (see 876 and the optical disk drive in FIG. 11) so that the software may be accessed.

Therefore, claims 1-7 are unpatentable over Reeder in view of Oshima, as presented in the rejections below.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeder (art of record) in view of Oshima (art of record).

With respect to claim 1 (currently amended), Reeder discloses a software program providing system for providing and managing access to a software program (see FIG. 1 and page 3, lines 11-15), comprising:

(a) a storage medium for storing said software program and an individual identification code for identifying said storage medium (see store 150 in FIG. 1, and page 5, lines 1-7, which shows a store or storage medium for storing a software program and an identification code used to identify the program in the storage medium, e.g. "the program is read from the store 34...");

(b) a user terminal for installing said storage medium therein and for accessing said software program stored in said storage medium (see apparatus 100 in FIG. 1, and page 3, lines 11-15 and line 32 to page 4, line 6, which shows a personal computer or user terminal having a storage medium installed therein for storing and accessing software programs; see also page 5, lines 10-14, which shows obtaining the software program and storing it in the storage medium);

(c) database management means for storing a database including individual information of a user, information regarding a range of access limitations to said software program, and

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information regarding a condition of access to said software program, wherein said database is searched using said individual identification code as a search key (see code data 230 in FIG. 1, and page 6, line 37 to page 7, line 5, which shows a data store or database having individual user information regarding software usage rights, i.e. access limitations and conditions of access, which is searched based on an identification code); and

(d) information communication means for connecting said database management means with said user terminal (see communications link 10 and network 20 in FIG. 1, and page 3, lines 21-31), wherein

said software program providing system authorizes said user terminal to access said software program stored in said storage medium based on said information regarding said range of access limitations (see page 7, lines 30-37), said information regarding said condition of access to said software program, and said information searched using said individual identification code as said search key (see page 6, line 37 to page 7, line 5), said database management means reading said individual identification code from said storage medium installed in said user terminal through said information communication means (see page 10, lines 6-17, which shows reading a identification code from a storage medium, and page 11, lines 15-29, which then shows authorizing the use of a software program based on access limitations and conditions).

Reeder does not expressly disclose limitation wherein said storage medium is a removable storage medium.

However, Oshima discloses a system for providing and managing access to a software program stored with an identification code on a removable, optical storage medium, wherein the

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software is installed on a user terminal from the removable storage medium, for the purpose of preventing illegal copying of the software (see column 10, lines 15-54; see also FIG. 11, which shows a personal computer or user terminal and an optical disk drive).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to provide the software program on a removable storage medium to be installed in the user terminal, as taught by Oshima. The modification would have been obvious because one of ordinary skill in the art would have been motivated to enhance the level of protection against illegal copying or installation of the software.

With respect to claim 2 (previously presented), Reeder further discloses the limitation wherein said database management means further comprises fee charging means for charging a fee according to said condition of access to said software program (see page 7, lines 22-29, which shows how software usage charges are recorded).

With respect to claim 3 (previously presented), Reeder further discloses the limitation wherein said information communication means further comprises ciphering means for ciphering communication between said database and said user terminal (see page 7, lines 5-9, which shows an encryption or ciphering process).

With respect to claim 4 (original), although Reeder discloses the use of encryption to provide additional security (see page 5, line 33 to page 6, line 1), Reeder does not expressly disclose the limitation wherein said storage means further comprises a DVD-ROM and said individual identification code includes a BCA code recorded through a laser beam during a fabrication process of said individual identification code.

However, Oshima further discloses the use of the BCA to store an identification code and a cryptographic key (see column 1, lines 36-50) on a DVD (see column 3, lines 63-67), so that a fee may be charged for the use of the disk (see column 4, lines 60-64). Oshima further discloses that the BCA code is recorded with a laser during fabrication and can be used for security (see column 3, lines 11-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to use a DVD-ROM storage medium with a BCA identification code, as taught by Oshima. The modification would have been obvious because one of ordinary skill in the art would have been motivated to improve security by transcribing the storage medium with an individual identification code.

With respect to claim 5 (currently amended), Reeder discloses a software program providing method for providing and managing access to a software program (see FIG. 1 and page 3, lines 11-15), comprising the following steps of:

(a) storing said software program in a storage medium along with an individual identification code for identifying said storage medium (see store 150 in FIG. 1, and page 5, lines 1-7, which shows a store or storage medium for storing a software program and an identification code used to identify the program in the storage medium, e.g. "the program is read from the store 34...");

(b) storing into a database, information regarding individual information of a user, information regarding a range of access limitations to said software program, and information regarding a condition of access to said software program, wherein said database is searched using said individual identification code as a search key (see code data 230 in FIG. 1, and page 6,

line 37 to page 7, line 5, which shows a data store or database having individual user information regarding software usage rights, i.e. access limitations and conditions of access, which is searched based on an identification code);

(c) communicating between a user terminal having said storage medium installed therein and a database management means managing said database (see communications link 10 and network 20 in FIG. 1, and page 3, lines 21-31),

wherein said communicating is done when said user accesses said software program stored in said storage medium installed in said user terminal (see page 5, lines 18-25, which shows initiating a transmission when the user accesses the software program); and

(d) authorizing said user terminal to access said software program based on said information regarding said range of access limitations (see page 7, lines 30-37), said information regarding said access condition to said software program, and said information searched from said database based on said individual identification code (see page 6, line 37 to page 7, line 5), wherein said individual identification code is read out from said storage medium installed in said user terminal (see page 10, lines 6-17, which shows reading a identification code from a storage medium, and page 11, lines 15-29, which then shows authorizing the use of a software program based on access limitations and conditions).

Reeder does not expressly disclose limitation wherein said storage medium is a removable storage medium.

However, Oshima discloses a system for providing and managing access to a software program stored with an identification code on a removable, optical storage medium, wherein the software is installed on a user terminal from the removable storage medium, for the purpose of



preventing illegal copying of the software (see column 10, lines 15-54; see also FIG. 11, which shows a personal computer or user terminal and an optical disk drive).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to provide the software program on a removable storage medium to be installed in the user terminal, as taught by Oshima. The modification would have been obvious because one of ordinary skill in the art would have been motivated to enhance the level of protection against illegal copying or installation of the software.

With respect to claim 6 (previously presented), Reeder further discloses the limitation wherein said process of providing authorization for accessing said software program further comprises the step of charging a fee according to said condition of access to said software program (see page 7, lines 22-29, which shows how software usage charges are recorded; see also page 9, lines 25-27).

With respect to claim 7 (previously presented), Reeder further discloses the limitation wherein said communicating step further comprises the step of ciphering communication between said user terminal and said database management means (see page 7, lines 5-9, which shows an encryption or ciphering process).

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (703) 305-0352. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

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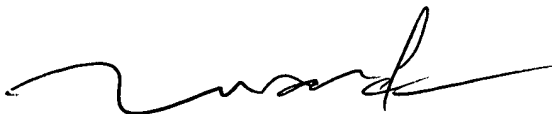
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MY

Michael J. Yigdall  
Examiner  
Art Unit 2122

mjy  
June 23, 2004

  
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SUPERVISORY PATENT EXAMINER